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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/577,210 | 04/27/2006 | Armin Gierling | ZAHFRI P854US | 1418 |
| 20210 7590 10/08/2008 DAVIS BUJOLD & Daniels, P.L.L.C. 112 PLEASANT STREET CONCORD, NH 03301 | | | | |
| EXAMINER | | | | |
| BONCK, RODNEY H | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3655 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 10/08/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/577,210

Applicant(s)

GIERLING, ARMIN

Examiner

Rodney H. Bonck

Art Unit

3655

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-33 and 35-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-33 and 35-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The following action is in response to the amendment received August 8, 2008.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the supply lines that do not lead through the common inner disc carrier (claim 54) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 31 is objected to because of the following informalities: In line 20 of claim 31, "inward!" apparently should be -- inward --. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 31-33 and 35-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 31, 54 and 56 are all directed to an assembly for activating first and second shifting elements, and the assembly is recited as comprising disc couplings or brakes that are in a transmission. The transmission is recited as having first and second disc packets, and the disc packets have inner and outer discs. Thus the claim appears to be defining three distinct sets of elements, the shifting elements, the disc couplings or brakes, and the first and second disc packets. From the disclosure, however, it appears that the shifting elements, disc couplings and disc packets are all referring to the same elements. This should be clarified in the claims because currently "the inner discs of the first and second friction shifting

elements" lack a proper antecedent basis since the inner discs were defined as part of the disc packets, not the friction shifting elements.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 31, 54 and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Hegerath(US 2004/0206599 A1). Hegerath discloses a pair of disc couplings in the form of disc packets having inner discs carried by a common inner disc carrier 11. The inner disc carrier has radial openings 36. Hegerath also provides cooling oil supply lines 34, 35 that do not extend through the disc carrier.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hegerath(US 2004/0206599 A1). Hegerath does not appear to specify whether any of the discs carry a friction lining. It is so well known in this art to put friction linings on a clutch disc that to do so in Hegerath would not have been a patentable modification.

Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hegerath(US 2004/0206599 A1) in view of either Zagrodzki et al.(US 2005/0284723 A1) or Okada et al.('397). The servo devices in Hegerath have a pressure plate with a ring shaped flange 29 extending out from the inner carrier to engage the disc pack. The disc engaging portions of the pressure plates appear to be continuous rather than distinct fingers. It is known in this art to provide the servo with radially aligned fingers that extend axially to engage the disc pack, as shown by Zagrodzki et al. and Okada et al. It would have been obvious to provide such fingers on the flanges 29 in Hegerath since the combination would have yielded predictable results to one having ordinary skill in this art.

Claim 54 is further rejected under 35 U.S.C. 103(a) as being unpatentable over Hegerath(US 2004/0206599 A1) in view of the German document G 91 14 528.7. While Hegerath is believed to meet this claim since passage 34, 35 for cooling oil do not lead through the inner disc carrier; Hegerath does provide openings for cooling oil in the carrier at 36. The German document discloses cooling oil passages 21 that do not

extend through the inner disc carrier 6. Oil apparently reaches the discs by passing around the end of the carrier. Since this is a known cooling arrangement, it would have been obvious to use this arrangement in Hegerath since this would have yielded predictable results to one having ordinary skill in this art.

Claims 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hegerath(US 2004/0206599 A1) in view of Park('177). In Hegerath both disc packets serve as disc couplings. Depending on the type of transmission, however, it would have been obvious provide one of more of the disc packets as a disc brake. In planetary transmissions, for example, disc packets are often used for gear ratio change, such as shown by Park. It would have been obvious to use the common disc carrier of Hegerath in a transmission wherein one or more of the disc packs is a disc brake since this would have yielded predictable results to one having ordinary skill in this art.

Allowable Subject Matter

Claim 56 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claims 35-53 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed August 8, 2008 have been fully considered but they are not persuasive. The claims as amended are still believed to be indefinite for the reasons set forth above. Regarding Hegerath applicant asserts that the common disc carrier does not define a "pot space". The examiner disagrees. The area inside the common carrier can be considered a pot space insofar as defined.

After reconsideration, it is believed that the examiner erred in indicating that claims 32, 33, 54 and 57 were directed to allowable subject matter. Therefore, new grounds of rejection are applied against these claims as set forth above. Since there are new grounds of rejection not necessitated by the amendment, this is not a final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney H. Bonck whose telephone number is (571) 272-7089. The examiner can normally be reached on Monday-Friday 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (571) 272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rodney H. Bonck/
Primary Examiner, Art Unit 3655

rhb
October 3, 2008